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10/032,889	12/26/2001	Bertram Geck	2001 P 18373 US	8303

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EXAMINER	
ROSE, KERRI M	

ART UNIT	PAPER NUMBER
2416	

MAIL DATE	DELIVERY MODE
12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/032,889	GECK ET AL.	
	Examiner	Art Unit	
	KERRI M. ROSE	2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11,13-16 and 20-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-11,13-16 and 20-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Please note AU 2616 is now AU 2416.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/04/2008 has been entered.

3. Applicant's arguments, see page 8, filed 9/4/08, with respect to the rejection(s) of claim(s) 1, 3, 6, 9, 15, 16, and 20-22 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of previously cited reference Fenton et al. (US 5,619,555).

4. Additionally, applicant argues that Staples and Weinstein cannot be combined. Staples references a generic telephone (fig. 11.1110) and generic public network (fig. 11.115). Since Staples does not limit the phone it could be an analog, cell, or wireless device. By the same reasoning the network may be a public telephone, cellular, or wireless network. Staples provides specific example for an analog phone coupled to a PSTN. Weinstein provides example of a cellular phone coupled to a cellular network and a WAP device coupled to a wireless network. Because Staples teaches only generic devices/networks, combining it with Weinstein would not result in changing the principle operation of Staples.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3, 6, 9, 15, 16, and 20-22 are rejected under 35 U.S.C. 103(a) as being anticipated by Staples et al. (US 2002/0118671) in view of Fenton et al. (US 5,619,555; previously cited).

7. In regards to claim 1, Staples discloses a virtual private communications network comprising: a communications server (figure 3A elements 110 and 120); a plurality of digital telephones connected to said communications server in a private telephone network (fig. 3A elements 142A-C; paragraph 35 indicates the office phones may be digital; the dashed line around the phones indicates they are part of the private network making up the office environment.); at least once communications trunk connecting said communications server to a public telephone network (fig. 3A both server 110 and server 120 are connected to the PSTN [with un-numbered lines]); a remotely connected device communicating with said communications server (fig. 3A.130); and a remote telephone (fig. 11.1110) connected to said public telephone network (fig. 11.115; connected through the remote device) and located in the vicinity of said remotely connected device (paragraph 182 indicates the remote phone and remote device are coupled together, which requires physical proximity), telephonic communications being provided to and from said remote telephone through said public telephone network in cooperation with said communications server and controlled by said remotely

connected device (fig. 11 illustrates how the remote device can be used to facilitate communication between a remote telephone and the communications server using PSTN), said remotely connected device and said remote telephone being a virtual digital telephone acting as a locally connected digital telephone in said private telephone network with access to digital telephone features, wherein said remotely connected device has access to all communications server features (paragraph 42 discloses the goal of the invention is to provide a remote user with a virtual digital phone with access to digital phone features and all the features of the communications server.).

Staples does not disclose a remote telephone *directly* connected to said public telephone network.

Fenton discloses a pair of remote telephones (fig. 1.22 and 24) associated with and in the vicinity of remote devices in column 4 lines 55-59. The remote telephones are directly connected to public network, fig. 1.20. Fenton states the remote device and telephone are not directly connected, however there is no reasoning given why they could not be directly associated. Therefore Fenton does not teach away from the proposed modification of Staples which would result in the remote telephone directly connected to the public telephone network, as taught by Fenton and the remote device, as taught by Staples.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the placement of the remote telephone taught by Staples, so as to be directly connected to the public network, as taught by Fenton because doing so allows for the user to choose whether to interface with the public network using the remote device, telephone, or combination, as taught by Fenton in column 2 lines 40-47. Additionally, there are a limited number of ways to

connect the remote telephone to the public network, namely either directly or indirectly. Therefore direct connection of the remote telephone to the public network would have been obvious to try.

8. In regards to claim 3, Staples discloses a VPCN as claimed in claim 1 wherein said remotely connected device is a web enabled device connected over the Internet (fig. 11.1113 is a modem for connecting to Internet 1119), said VPCN further comprising: a web server connected to said communications server and the Internet (fig. 11.1118).

9. In regards to claim 6, Staples discloses a VPCN as in claim 1 wherein said communications server is a PBX server (paragraph 110) providing said digital telephone features, said features comprising: call connection processing (p. 8 and 9); call status (p. 23); partner identification (p.22); call duration (p.23); incoming call indication (p. 9 and 22); call hold/resume (p.19 and 20); consultation (p.13); redial (p.21); call forwarding (p.12); speed dialing (p.23); and a local address book (p.23).

10. In regards to claim 9, Staples discloses a VPCN comprising: a PBX server (fig. 3A.110); a web server connected to said PBX server and the Internet (fig. 11.1118); a plurality of digital telephones connected to said PBX server in a private telephone network (fig. 3A elements 142A-C; paragraph 35 indicates the office phones may be digital; the dashed line around the phones indicates they are part of the private network making up the office environment.); at least once communications trunk connecting said PBX server to a public telephone network (fig. 3A both server 110 and server 120 are connected to the PSTN [with un-numbered lines]); a remotely connected device communicating with said PBX server (fig. 3A.130); and a remote telephone (fig. 11.1110) connected to said public telephone network (fig. 11.115; connected through the

remote device) and located in the vicinity of said remotely connected device (paragraph 182 indicates the remote phone and remote device are coupled together, which requires physical proximity), telephonic communications being provided to and from said remote telephone through said public telephone network in cooperation with said PBX server and controlled by said remotely connected device (fig. 11 illustrates how the remote device can be used to facilitate communication between a remote telephone and the communications server using PSTN), said remotely connected device and said remote telephone being a virtual digital telephone acting as a locally connected digital telephone in said private telephone network with access to digital telephone features, wherein said remotely connected device has access to all PBX server features (paragraph 42 discloses the goal of the invention is to provide a remote user with a virtual digital phone with access to digital phone features and all the features of the communications server.).

Staples does not disclose a remote telephone *directly* connected to said public telephone network.

Fenton discloses a pair of remote telephones (fig. 1.22 and 24) associated with and in the vicinity of remote devices in column 4 lines 55-59. The remote telephones are directly connected to public network, fig. 1.20. Fenton states the remote device and telephone are not directly connected, however there is no reasoning given why they could not be directly associated. Therefore Fenton does not teach away from the proposed modification of Staples which would result in the remote telephone directly connected to the public telephone network, as taught by Fenton and the remote device, as taught by Staples.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the placement of the remote telephone taught by Staples, so as to be directly connected

to the public network, as taught by Fenton because doing so allows for the user to choose whether to interface with the public network using the remote device, telephone, or combination, as taught by Fenton in column 2 lines 40-47. Additionally, there are a limited number of ways to connect the remote telephone to the public network, namely either directly or indirectly. Therefore direct connection of the remote telephone to the public network would have been obvious to try.

11. In regards to claim 15, Staples discloses a method for communicating with a private communications network comprising: connecting a remotely located web enabled device (fig. 3a.130 discloses a remote device which may communicate with the internet [fig. 11.1118]) to a communications server (fig. 3a.110) in a private telephone network (fig. 3a and 11 illustrate the remote device connects to the private telephone network); providing said remotely located web enabled device with access to private network telephony features from said communications server (paragraph 42 discloses the goal of the invention is to provide a remote user with a virtual digital phone with access to digital phone features and all the features of the communications server.); initiating calls at the communications server from and to a remote telephone in the vicinity of said remotely located web enabled device (remote phone, fig. 11.1110; paragraph 182 indicates the remote phone and remote device are coupled together, which requires physical proximity), said calls being through a public telephone network connected to said remote telephone (fig. 11.115; connected through the remote device), said remotely located web enabled device initiating and controlling said calls (fig. 11 illustrates how the remote device can be used to facilitate communication between a remote telephone and the communications server using PSTN), wherein providing said remotely located web enabled device with access provides

said remotely located web enabled device with access to all communications server features (paragraph 42 discloses the goal of the invention is to provide a remote user with a virtual digital phone with access to digital phone features and all the features of the communications server.).

Staples does not disclose a remote telephone *directly* connected to said public telephone network.

Fenton discloses a pair of remote telephones (fig. 1.22 and 24) associated with and in the vicinity of remote devices in column 4 lines 55-59. The remote telephones are directly connected to public network, fig. 1.20. Fenton states the remote device and telephone are not directly connected, however there is no reasoning given why they could not be directly associated. Therefore Fenton does not teach away from the proposed modification of Staples which would result in the remote telephone directly connected to the public telephone network, as taught by Fenton and the remote device, as taught by Staples.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the placement of the remote telephone taught by Staples, so as to be directly connected to the public network, as taught by Fenton because doing so allows for the user to choose whether to interface with the public network using the remote device, telephone, or combination, as taught by Fenton in column 2 lines 40-47. Additionally, there are a limited number of ways to connect the remote telephone to the public network, namely either directly or indirectly. Therefore direct connection of the remote telephone to the public network would have been obvious to try.

12. In regards to claim 16, Staples discloses a method as in claim 15 wherein the step of connecting the remotely located web enabled device comprise the steps of: calling an Internet

service provider (Inherent; a dial-up modem, such as fig. 11.1113 must first call the service provider to establish a connection); negotiating a modem connection with said ISP (Inherent; once the modem has contacted the ISP it negotiates for access); and connecting to a web server connected to said communications server, calls to said remote telephone being controlled by said web enabled device in real time (fig. 12 and p. 183-186 disclose how to ensure real time operation.).

In regards to claim 20, Staples discloses a virtual private communications network comprising: a communications server in a private network (figure 3A elements 110 and 120); at least once communications trunk connecting said communications server to a public telephone network (fig. 3A both server 110 and server 120 are connected to the PSTN [with un-numbered lines]); a remotely connected device communicating with said communications server (fig. 3A.130); and a remote telephone (fig. 11.1110) connected to said public telephone network (fig. 11.115; connected through the remote device) and located in the vicinity of said remotely connected device (paragraph 182 indicates the remote phone and remote device are coupled together, which requires physical proximity), telephonic communications being provided to and from said remote telephone through said public telephone network in cooperation with said communications server and controlled by said remotely connected device (fig. 11 illustrates how the remote device can be used to facilitate communication between a remote telephone and the communications server using PSTN), said remotely connected device and said remote telephone being a virtual digital telephone acting as a locally connected digital telephone in said private telephone network with access to digital telephone features, wherein said remotely connected device has access to all communications server features (paragraph 42 discloses the goal of the

invention is to provide a remote user with a virtual digital phone with access to digital phone features and all the features of the communications server.).

Staples does not disclose a remote telephone *directly* connected to said public telephone network.

Fenton discloses a pair of remote telephones (fig. 1.22 and 24) associated with and in the vicinity of remote devices in column 4 lines 55-59. The remote telephones are directly connected to public network, fig. 1.20. Fenton states the remote device and telephone are not directly connected, however there is no reasoning given why they could not be directly associated. Therefore Fenton does not teach away from the proposed modification of Staples which would result in the remote telephone directly connected to the public telephone network, as taught by Fenton and the remote device, as taught by Staples.

13. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the placement of the remote telephone taught by Staples, so as to be directly connected to the public network, as taught by Fenton because doing so allows for the user to choose whether to interface with the public network using the remote device, telephone, or combination, as taught by Fenton in column 2 lines 40-47. Additionally, there are a limited number of ways to connect the remote telephone to the public network, namely either directly or indirectly. Therefore direct connection of the remote telephone to the public network would have been obvious to try.

14. Claims 21 and 22 are rejected upon the same grounds as claim 6.

15. Claims 4, 5, 7, 8, 10, 11, 13, 14, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples et al. (US 2002/0118671) in view of Fenton et al. (US 5,619,555) further in view of Weinstein et al. (US 2001/0026609).

16. In regards to claim 4, Staples discloses a VPCN as in claim 3, wherein said web enabled device is a personal computer (fig. 11.112), but does not disclose selecting a corresponding remote telephone.

Weinstein discloses in paragraph 8 the system dials the caller and the callee according to selected numbers and then bridges the call. Additionally, paragraph 76 discloses selecting the remote telephone in a preference order set by the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to select a remote telephone, as disclosed by Weinstein, in the VPCN disclosed by Staples because doing so allows the user to specify the preferred telephone to use, based upon for example the time of day, as described in paragraph 76 of Weinstein. This helps ensure call completion regardless of the time or location of the user.

17. In regards to claim 5, Staples discloses wherein at least one PC includes a modem (fig. 11.1113) connecting to the Internet (fig. 11.1119), over a second public network, different than said public network (fig. 11.1118).

18. In regards to claim 7, Staples discloses a VPCN as in claim 1, but not wherein said remote telephone is a WAP device connected over the Internet.

Weintein discloses a WAP device connected over the Internet in paragraph 8.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a WAP device as the remote telephone, as taught by Weinstein, in the VPCN of Staples

because devices such as cell phones and PDAs are widely used and easy to carry anywhere. Additionally, many households are only using cell phones, so even if a worker is at home a landline phone may not be available.

19. In regards to claim 8, Staples, Fenton and Weinstein disclose wherein said WAP is a PDA (Weinstein paragraph 8), with a wireless connection to the Internet separate from said remotely connected device (Weinstein teaches wireless access protocol and therefore teaches a wireless connection. Fenton discloses connecting the remote telephone to a network separate from the remote device in fig. 1 elements 20 and 22.).

20. Claims 10 and 14 are rejected upon the same grounds as claims 4 and 8 respectively.

21. In regards to claim 11, Staples discloses wherein at least one PC includes a modem (fig. 11.1113) connecting to the Internet (fig. 11.1119), said at least one PC being connected to the web server (fig. 11.1118) over the Internet.

22. In regards to claim 13, In regards to claim 8, Staples, Fenton and Weinstein disclose wherein at least one remote telephone is a WAP device (Weinstein paragraph 8), connected over the Internet separate from said remotely connected web enabled devices (Weinstein teaches wireless access protocol and therefore teaches a wireless connection. Fenton discloses connecting the remote telephone to a network separate from the remote device in fig. 1 elements 20 and 22.).

23. In regards to claim 23, Staples discloses a VPCN as in claim 1 wherein said remotely connected device is an analog telephone (fig. 11.1110) connected to a land line to said public telephone network (fig. 11.115 discloses a generic network such as PSTN). Staples does not

disclose wherein said remotely connected device is one of a plurality of devices comprising a cell phone connected to a cellular network and a WAP connected to a wireless network.

Weinstein discloses choosing between a plurality of devices in paragraphs 8 and 76. Weinstein discloses a cell phone and WAP device as one of the plurality of choices for remotely connected device in paragraph 8. Staples does not limit the type of public network disclosed in fig. 11.115 and therefore teaches networks such as cellular and wireless. Additionally, a cellular device must first pass through a cellular network before communicating with another network, such as PSTN and a WAP must first pass through a wireless network because such devices do not have direct connections to other network types available to them.

It would have been obvious to one of ordinary skill in the art at the time of the invention to choose between different devices, as taught by Weinstein, in the VPCN taught by Staples because doing so allows the user to specify the preferred telephone to use, based upon for example the time of day, as described in paragraph 76 of Weinstein. This helps ensure call completion regardless of the time or location of the user.

24. Claims 24 and 25 are rejected upon the same grounds as claim 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERRI M. ROSE whose telephone number is (571) 272-0542. The examiner can normally be reached on Monday through Thursday, 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung MOE can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aung S. Moe/
Supervisory Patent Examiner, Art Unit 2416

/Kerri M Rose/
Examiner, Art Unit 2416